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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,649	08/27/2001	Helen O'Hara	021058/0257402	3549

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,649

Applicant(s)

O'HARA ET AL.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 18-35 and 37-59 is/are pending in the application.
- 4a) Of the above claim(s) 23-35 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 18-22 and 37-59 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**PRIORITY, OBJECTIONS AND REQUIREMENTS**

1. In this application, notice is taken of the claim for priority based on the prior PCT application and on the preceding Australian application. This claim, as to the preceding Australian application, is denied since the instant invention is not described as required by 35 U.S.C., section 119, and section 112, first paragraph, in the original application, for the significant additions to the PCT application, including many additional claims, examples and generally significantly more disclosure. This application is a divisional application of the US national stage of the original PCT application, but which contains new matter as judged under the law of this country, the proper inquiry upon the entry to the national stage. The benefit of the PCT filing date of 24 December 1996 is granted as to the PCT disclosure as of that time, but not the previous, Australian national priority from December, 1995.
2. Claims 23-35 and 37 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall not form the basis for another multiple dependent claim. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.
3. The substitute specification filed February 20, 2002 has not been entered because it does not conform to 37 CFR 1.125(b) for reasons including the following. The remarks indicate that preliminary amendments have been incorporated into the substitute specification. However, applicants failed to provide a marked-up copy as required for such amendments (but not, for example, for mere paragraph numbering), as required by Rule 125(b)(2). It appears the claims were renumbered starting from claim 1 in the substitute specification. This is improper, see paragraph 5 below. Further, there is no statement by applicants that the substitute specification includes no new matter, Rule 125(b)(1). A new substitute specification in accordance with 37 CFR 1.125(b) (and other rules as appropriate including 37 CFR 1.121 and 1.126) is required.

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4. Applicants are reminded of the rejection under 35 USC 112, first paragraph from the parent application. This application contains new matter, as compared to the original PCT application, in the exclusionary phrase of claim 1, for example. The required statement regarding the substitute specification including no new matter should be noted a drafted with care, as this statement is submitted in accordance with applicants' duty of candor to the Office.

5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). In this regard, applicants' remarks in the preliminary amendment of August 27, 2001, on pages 1 and 5 thereof regarding canceling claims 42-43, and otherwise about the claims, including the claims in this application, are not understood. The highest previous claim number in this case was only claim 40. Perhaps applicants were confused regarding an amendment(s) from the parent application, but which are not of record herein.

Misnumbered claims 44-62 been renumbered 41-59.

## **REJECTIONS**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 38-40 are rejected under 35 USC 112, 2<sup>nd</sup> paragraph, as nonstatutory, failing to particularly point out and distinctly claim the invention.

Clearly, claims under US rules, e.g., 37 CFR 1.75, may depend from other claims, but not from the specification. These claims should be cancelled. If applicants desire to elect one of these

claims, applicants should group the claim with the appropriate group of claims below, or as to claim 38, should present and elect a proper composition claim drawn to the gasser solution claim.

#### **RESTRICTION/LACK OF UNITY**

8. Restriction is required under 35 U.S.C. 121 and 372.
9. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to an emulsion explosive.

Group II, claim(s) 18-22, drawn to a first method of making.

Group III, claim(s) 41-59, drawn to a second, quick method of making.

10. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: There is believed to be no special technical feature which is effective for unity under the Rule. See PCT Rule 13.2,

“... The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”

and note the prosecution in the parent application of this application. As to Groups II and III, the method of each Group could make the composition of Group I. Thus, applicants have not complied with the requirement that they may have a single Group of invention in a plurality of classes, such as a composition and a method of making thereof.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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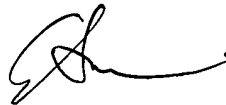
12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

13. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
September 20, 2002



EDWARD A. MILLER  
PRIMARY EXAMINER